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09/699,863	10/30/2000	Jukka Heiska	4925-64	6891

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EXAMINER
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MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/699,863

Applicant(s)

HEISKA, JUKKA

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-14 are pending. A formal action on the merits of claims 1-14 follows.
2. Action is based on Preliminary Amendment filed by applicant on 10/30/2000.

### *Specification*

3. The disclosure is objected to because of the following informalities:

- On Page 6 line 3, "intent" is misspelled and should be -- Internet --.

Appropriate correction is required.

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to specifically show how the documents are adjusted within the content converter as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

5. Claim 12 is objected to because of the following informalities:
  - Claim 12 recites that it is dependent upon the "apparatus of claim 7." Claim 7 is a method claim. Applicant interprets this error to mean "the apparatus of claim 8", which

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is how it has been interpreted in the current office action. Please provide the proper correction

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-7 are rejected under 35 U.S.C. 102(a) as being anticipated by Carlino et al. (WO 00/39666).

With respect to claim 1, Carlino teaches a method for providing data services to mobile devices in a system comprising a data network, at least one content server accessible via the data network, at least one gateway for accessing the data network, a mobile telephone network for communicating between the mobile devices and said at least one gateway, and a content converter connected to the data network [**Carlino -- Figure 1 and Abstract - Discloses original document in World Wide Web (WWW) (20), implicitly residing on a content server, i.e. computer, server, etc., wireless gateway (14), mobile telephone (12) and content converter (16)**], the method comprising:

uploading to the content converter and storing therewith indications of the characteristics of each terminal device [Carlino -- Page 33 lines 10-19 -- Database 18 contains wireless device preferences, i.e. characteristics, which are specific to the particular wireless device, i.e. type of display, i.e. number of viewable lines on screen. In order for the preferences to exist in the database 18, it is required that they were uploaded to content converter and its associated database];

routing content for a particular mobile terminal from said at least one content server to the content converter [Carlino -- Figure 1 and page 18 lines 19-23 -- Original document from WWW is received at content converter from its source];

adjusting content for the particular mobile terminal in the content converter according to the stored characteristics of the mobile terminal [Carlino -- Page 9 lines 1-7 -- Content converter converts original document, i.e. web page, etc., from one markup language to another markup language, in addition to, following the preferences stored in the database];  
and

routing the adjusted content through the data network to said at least one gateway for forwarding to said particular mobile terminal [Carlino -- Figure 1 and Page 33 lines 19-23 -- Wireless gateway (14), shown in figure 1, both receives requests and sends converted document to mobile device, i.e. mobile phone].

With respect to claim 2, Carlino further teaches wherein the content is in wireless application protocol (WAP) format [Carlino -- Page 33 lines 1-5 -- Document is in WAP format using WML].

With respect to claim 3, Carlino further teaches wherein the data network is a wide-area network (WAN) **[Carlino -- Figure 1 -- World Wide Web or Internet is used to retrieve documents from other servers, computers etc... The Internet is classified as a WAN].**

With respect to claim 4, Carlino further teaches wherein the WAN is the Internet **[Carlino -- Figure 1 and Page 14 lines 13-16 -- World Wide Web on the Internet].**

With respect to claim 5, Carlino further teaches the step of uploading to the content converter and storing therewith indications of preferences of the user of each terminal device, and wherein the step of adjusting content is according to said stored preferences of the user **[Carlino -- Page 9 lines 1-7 and page 45 lines 3-13 -- Database stores uploaded characteristics of devices and preferences of the user of the device which is used by the content converter to render documents in a manner viewable on a particular wireless device].**

With respect to claim 6, Carlino further teaches wherein content is adjusted in accordance with a preference currently entered by the user and stored **[Carlino -- Page 9 lines 1-7 -- Content converter uses preferences and characteristics of users stored in database to adjust the original document, i.e. convert it to format suitable for wireless device. The user can make these preferences at any time and store them in the database].**

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With respect to claim 7, Carlino further teaches wherein content is adjusted in accordance with a preference previously stored and currently selected by the user [**Carlino -- Page 9 lines 1-7 and page 45 lines 3-13 – Content converter adjusts content to that of user preferences previously stored, i.e. user stores preferences for baseball scores to render them on wireless device, in a given manner**].

8. Claims 8-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Carlino et al. (WO 00/39666).

With respect to claims 8-14, these are apparatus claims corresponding to the methods claimed in claims 1-7. They have similar limitations; therefore, claims 8-14 are rejected under the same rationale.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Martin, Jr. et al. (U.S. 6,610,105).

With respect to claim 1, Martin teaches a method for providing data services to mobile devices in a system comprising a data network, at least one content server accessible via the data network, at least one gateway for accessing the data network, a mobile telephone network for communicating between the mobile devices and said at least one gateway, and a content converter connected to the data network [Martin -- Figures 4B, 5B, Col. 4 line 49 and Col. 5 lines 18-22 and 43-45 – Data network comprises link server, i.e. gateway, mobile telephone, central content server and content converter, resident in host server], the method comprising:

uploading to the content converter and storing therewith indications of the characteristics of each terminal device [Martin -- Col. 6 lines 52-65 and Col. 9 lines 30-37 – Shared database contains characteristics of device used to help render, i.e. convert pages];

routing content for a particular mobile terminal from said at least one content server to the content converter [Martin -- Figures 4B, 5A, 5B and Col. 4 lines 49-51 – Content from content server, as shown, is routed through host server, which contains converting mechanism];

adjusting content for the particular mobile terminal in the content converter according to the stored characteristics of the mobile terminal [Martin -- Figures 4B, 5B, Col. 4 lines 49-51, Col. 9 lines 30-37 and Col. 11 lines 22-28 – Converter, in host server, has access to the



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**database of device characteristics, upon which the content is converted to suit the particular device]; and**

routing the adjusted content through the data network to said at least one gateway for forwarding to said particular mobile terminal [**Martin -- Figures 4B, 5A, 5B, Col. 2 lines 40-42 and Col. 13 lines 1-2 – Content is sent to link server, i.e. gateway, and forwarded to mobile device].**

11. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Martin, Jr. et al. (U.S. 6,610,105).

With respect to claim 8, this is an apparatus claim corresponding to the method claimed in claim 1. It has similar limitations; therefore, claim 8 is rejected under the same rationale.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Lee et al. (U.S. 6,336,137) discloses a system for distributing data to mobile devices using a language specified in a token by the mobile device.

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- Himmel (U.S. 6,167,441) discloses a system for customizing a web page for a mobile device based upon requestor type, i.e. device requesting the content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



TJM  
January 13, 2004



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